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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,475	05/24/2001	John B. Lowe	209013US55 CONT	2187

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EXAMINER
PROUTY, REBECCA E

ART UNIT	PAPER NUMBER
1652	14

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/863,475

Applicant(s)
Lowe

Examiner
Rebecca Prouty

Art Unit
1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 15, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18, 20-22, 25, and 27-52 is/are pending in the application.
- 4a) Of the above, claim(s) 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-18, 20-22, 25, and 30-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 13 6) ☐ Other:

Art Unit: 1652

Claims 1-8, 19, 23, and 26 have been canceled. Claims 9-18, 20-22, 24, 25, and 27-52 are still at issue and are present for examination.

Applicants' arguments filed on 5-15-03, paper No. 12, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claims 27-29 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

This application contains claims 27-29 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 36, 41, 46 and 51 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 1652

The recitation of the minimal catalytic domain of the galactosyltransferase of SEQ ID NO:4 as amino acids 43-361 in these claims lacks support in the application as filed. The specification discloses the minimal catalytic domain of the galactosyltransferase of SEQ ID NO:4 as amino acids 63-394.

Applicants amendment corrected the C-terminal amino acid residue number but failed to correct the amino terminal amino acid residue number.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 9-18, 20-22, 25, and 30-52 are rejected under 35 U.S.C. 102(a) as being anticipated by Larsen et al.

Larsen et al. teach a murine nucleic acid identical to SEQ ID NO:3 which encodes SEQ ID NO:4, and the cloning and expression of this nucleic acid to produce the encoded protein and a Protein A fusion to amino acids 63-394 encoding the minimal catalytic domain of this galactosyltransferase.

Applicants submitted a *In re Katz* declaration by Dr. Lowe to show that the cited reference is a disclosure of applicants own

Art Unit: 1652

invention within one year of the filing date of the instant application and thus is not prior art against the instant application. This is not persuasive because the declaration provides evidence that Dr. Richard Cummings provided an inventive contribution to the instant invention and thus the Larsen et al. reference remains a disclosure "by another". As stated in the declaration Dr. Cummings provided the suggestion to focus on the specific claimed murine galactosyltransferase gene; the suggestion of the specific lectin to be used within the generic glycosyltransferase expression cloning method developed by Dr. Lowe in order to apply the generic method to the specific gene; and provided a suggestion of the specific mouse cell type to use as a good mRNA source. As such Dr. Cummings clearly conceived the specific gene to focus on and **all** the specific details necessary for the application of the generic method to this gene and thus clearly is a co-inventor of the specific claimed nucleic acids. While the information disclosure statement filed 6-12-03 shows Dr Cummings has relinquished all rights to claims of co-inventorship of the instant invention following a protracted inventorship dispute (which appears to have focused mostly on the generic invention of the expression cloning method and not on the specific gene currently claimed), the waiver of all rights does

Art Unit: 1652

not alter the fact that Dr. Cummings clearly contributed to the conception of the instantly claimed gene. The examiner notes that the information disclosure statements clearly evidence that Dr. Lowe has signed declarations stating that he is the sole inventor based on inventorship opinions furnished to him by his patent attorneys despite his own reservations, as he is not knowledgeable on the specifics of the law regarding inventorship in a legal sense. It is further noted that these opinions are not present in the information disclosure statement filed regarding the inventorship dispute.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

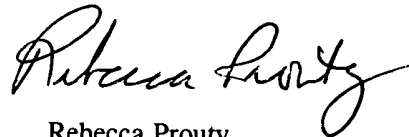
Art Unit: 1652

statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (703) 308-4000. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy, can be reached at (703) 308-3804. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Rebecca Prouty
Primary Examiner
Art Unit 1652